

II. Remarks

Reconsideration of the application as amended is respectfully requested.

The Office Action of May 4, 2005 at page 2 recites a claim rejection under 35 U.S.C §102. In a telephone conference between applicants' attorney and the examiner on May 24, 2005 the examiner advised applicants' attorney that there is no rejection of claims under 35 U.S.C §102 and that reference to such a rejection in the Office Action should be disregarded. Accordingly in this response to the Office Action applicants have disregarded the reference to a 35 U.S.C §102 rejection.

The examiner has rejected claims 1-14 under 35 U.S.C §112 for indefiniteness due to the recitation in claim 1 of "the sport fish" without antecedent basis. Claim 1 has been amended to delete "the sport" whereby the claim is no longer indefinite. In addition independent claims 15 and 24 have likewise been amended to delete "the sport" preceding the recitation to "fish." Withdrawal of the 35 USC §112 rejection is respectfully requested.

No other amendments to the claims have been made.

All of the claims of the application stand rejected under 35 U.S.C 103(a).

Applicants traverse the rejections of the claims under 35 U.S.C 103(a).

Claim 1 has been rejected on Fima in view of Treon and Garr. Claim 1 recites a lure body housing with generally light-transmissive sidewalls and a jacket installed on the body made of a light-transmissive material. It is the position of the examiner that Fima discloses a body made of light transmissive material. However the disclosure of Fima makes no reference to a body made of a light transmissive material and does not appear to have one. Fima has a body with an interior space that holds a light 38. Fiber optic

bundles 44 extend through openings provided in the lure body to eyes 46 mounted on the lure body. Light is transmitted through the fiber optic bundles. Light is not transmitted through the body. Openings in the body to accommodate fiber optics do not render the material of the body light-transmissive. The body is not made of a light transmissive material. In addition Fima has no jacket. The item 12 of Fima referenced by the examiner is not a jacket. The item 12 is described by Fima (column 2, line 8): "It (the lure) has an elongated body 12 of a generally fish-like shape with two fish hooks 14 attached at the bottom."

Claim 1 recites a first linear bank of display lights installed in the housing with light-transmissive walls, the bank of display lights including a set of spaced apart lights viewable through the sidewalls of the housing. However in the patent to Fima the light 38 is a single light. It is not a bank of lights much less a bank of spaced apart lights. The light 38 is not viewable through the sidewalls of the lure body. The optic fibers are not lights. The optic fibers carry lights. The optic fibers are installed in openings in the housing. In the claim optic fibers and lights are distinct elements. Fima recognizes that optic fibers and lights are separate elements.

It is the position of the examiner that while Fima does not disclose a linear bank of display lights, Treon does. The examiner states that "Treon does disclose the first light – see the sidewalls of the lure in figure 1, is a linear bank of lights – see for example figure 1." However Treon discloses only a single light 32. It does not disclose a set of spaced apart lights. Light is transmitted from light 32 through strands of fiber optic bundles to various parts of the lure. The linear arrangement of a series of ends of fiber optic strands is not a bank of spaced apart lights. The fiber optic strands and lights are

entirely different elements as described in the specification of the application and recited in the claims. As disclosed in the patents to Fima and Treon the lights and fiber optic strands are entirely different elements.

In addition a combination of the Fima and Treon references as proposed by the examiner would produce a lure with end points of the illuminated fiber optic strands located on the exterior of the lure body. There would be no linear bank of lights viewable through the sidewalls of the housing. Moreover there is no suggestion or impetus of any sort to combine the teachings of Fima and Treon. Fima has a single light in front and a single aft light and a fiber optic bundle at the aft end. Treon has a single light and a fiber optic bundle at the aft end. There is no purpose to a combination of the references.

Claim 1 recites a circular bank of display lights installed in the housing aft of the first linear bank of lights and including a set spaced apart, aft facing lights. Fima does not have such a circular bank of lights. There is a single light 40. There are no lights that are spaced apart. There is no circular bank of lights.

The examiner takes the position that Garr discloses a circular bank of display lights, and that it would have been obvious to one of ordinary skill in the art to take the device of Fima and add the circular bank of display lights of Garr. Garr discloses a fishing lure with external LED lights 3 located about the mid-section of the lure body, and a light 3 at the aft end of the lure body. A combination of Fima and Garr would not produce a device with a circular bank of display lights installed in the housing at a location next to a fiber optic bundle so that the fiber optic bundle will receive light from the circular light bank. Both Fima and Garr have lights at the aft end. Combining Garr

with Fima would produce a Fima lure with a ring of lights arranged exteriorly about an intermediate section of the lure body.

A combination of the Fima and Garr references as suggested by the examiner is improper. There is no teaching, suggestion or incentive to combine the references in a manner as suggested by the examiner. Fima already has a light at the aft end facing the optic fiber bundle. Garr also has a light at the end. There is no teaching to place the ring of lights around the mid-section of the Garr lure in any position but around a mid-section. There is no teaching or apparent reason to replace the light at the aft end of either Garr or Fima with a circular bank of lights. MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Absent motivation, a combination of references is improper. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

Claim 1 is not obvious in view of the references in combination as suggested by the examiner. The proposed combination of references is improper. Accordingly allowance of claim 1 is respectfully requested.

Claims 2 through 14 depend from claim 1 or claims dependent thereon. Allowance of dependent claims 2 through 14 is respectfully requested.

In addition applicants note that claim 2 has been rejected under Fima as modified by Treon and Garr. It is the examiner's position that Treon discloses a second linear bank of lights. Treon however does not contain such a disclosure. Treon discloses a single light and multiple optic fiber strands which are elements separate and distinct from lights. Treon, Garr and the disclosure of the present application all distinguish between

lights and fiber optic strands that transmit lights. It is erroneous to equate the fiber optic strands that carry light with the light itself.

Claims 3 and 12 are rejected as obvious under Fima, Treon and Garr. It is the examiner's position that Fima discloses a flasher module. Fima does not teach a flasher module. Fima teaches a switch that operates two lights which switch has multiple contacts and a rolling contact closer. The switch is open or closed depending on the location of the rolling contact. If the contact remains stationary the switch is either open or closed and stays that way. There is no flasher module. Accordingly claims 3 and 12 are not rendered obvious by a combination of Fima, Treon and Garr.

Claims 4 and 13 are rejected as obvious under Fima, Treon and Garr. It is the position of the examiner that Fima discloses a flasher module operative to sequentially flash lights of the light banks. Fima does not disclose a flasher module. Fima disclosed a switch with a rolling contact. The switch operates two lights together. The lights may or may not illuminate multiple strands of fiber optic cable. There is no sequential flashing of lights. There is not even a sequential flashing of illumination at the ends of the fiber optic strands. Light is transmitted through the fiber optic strands together. There is no sequence. Accordingly claims 4 and 13 are not rendered obvious by a combination of Fima, Treon and Garr.

Claim 5 is rejected under Fima as modified by Treon and Garr. It is the position of the examiner that Fima discloses a metal leader tube. The position of the examiner is apparently that the structure of Fima defining the guideway 24 constitutes a metal leader tube. The guideway does not pass centrally through the center of the lure body. It cannot

accommodate a leader which is the purpose of a leader tube. Accordingly claim 5 is not rendered obvious by a combination of Fima, Treon and Garr.

Claim 8 is rejected under 35 U.S.C. 103(a) under Fima as modified by Treon and Garr and further in view of Liebert. Liebert discloses a simulated eye construction for a fish lure. The eye is made of an epoxy resin. The epoxy resin does not encapsulate a linear light bank, a circular light bank, a battery pack, a switch and a flasher module. Liebert is simply a disclosure of an epoxy eye for a fish lure. A combination of Liebert with Fima, Garr or Treon would yield a fishing lure with epoxy eyes. This would defeat the purpose of the Fima lure which has eyes configured as the ends of fiber optic strands. Accordingly not only would the proposed combination with Liebert not yield the claimed invention, there is no teaching, suggestion or incentive to combine the references.

Allowance of claim 8 is respectfully requested.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Treon and Garr and further in view of Ray. Ray discloses a magnetically operated reed switch that is operated by a magnet contained internally of the lure such that the reed switch is closed by a jarring movement imparted to the body of the lure. Claim 9 recites a switch that is controlled by use of a magnet positioned externally to the lure. The combination of references as proposed by the examiner would not produce a lure with a reed switch controlled by a magnet positioned externally to the lure.

Allowance of claim 9 is respectfully requested.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Treon and Garr and further in view of Malphrus. However Fima does not disclose a jacket. The item 12 of Fima referenced by the examiner is not a jacket. The

item 12 is described by Fima (column 2, line 8): "It (the lure) has an elongated body 12 of a generally fish-like shape with two fish hooks 14 attached at the bottom." Malphrus discloses a lure having a skirt resembling the tentacles of a squid. Malphrus does not disclose a jacket. The combination of references as proposed by the examiner would not produce a lure as defined by claim 10. Allowance of claim 10 is requested.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fima as modified by Treon and Garr and further in view of West. West discloses a fishing lure containing rechargeable batteries. West does not disclose a recharging circuit connected to the batteries and a recharging receptacle installed in the housing sidewalls. The examiner states (page 8 of the Office Action) that West discloses "a recharging circuit connected to the batteries - see for example at 22-38 in figure 2, and a recharging receptacle installed in the housing sidewalls - see for example at 12-18 in figure 2." However West does not disclose a recharging circuit. The item 22 is a D.C. motor that operates an eccentric weight to produce vibration. The items 38 are externally exposed leads (column 4, line 37). When submerged the water closes the circuit between the leads to switch the circuit to ON to effect vibration of the fishing lure. There is no recharging receptacle. The items 12-18 referenced by the examiner constitute the lure body. Accordingly the combination of references as proposed by the examiner would not produce a lure as defined by claim 11. Allowance of claim 11 is respectfully requested.

Claim 15 has been rejected on Fima in view of Treon and Garr. Like claim 1, claim 15 recites a lure body housing with generally light-transmissive sidewalls and a jacket installed on the body made of a light-transmissive material. As with respect to claim 1, it is the position of the examiner that Fima discloses a body made of light

transmissive material. However the disclosure of Fima makes no reference to a body made of a light transmissive material and does not appear to have one. Fima has a body with an interior space that holds a light 38. Fiber optic bundles 44 extend through openings provided in the lure body to eyes 46 mounted on the lure body. Light is transmitted through the fiber optic bundles. Light is not transmitted through the body. Openings in the body to accommodate fiber optics do not render the material of the body light-transmissive. The body is not made of a light transmissive material.

Claim 15 also recites a circular bank of display lights installed in the housing aft of the first linear bank of lights and including a set spaced apart, aft facing lights. Fima does not have such a circular bank of lights. There is a single light 40. There are no lights that are spaced apart. There is no circular bank of lights.

The examiner again takes the position that Garr discloses a circular bank of display lights, and that it would have been obvious to one of ordinary skill in the art to take the device of Fima and add the circular bank of display lights of Garr. Garr discloses a fishing lure with external LED lights 3 located about the mid-section of the lure body, and a light 3 at the aft end of the lure body. A combination of Fima and Garr would not produce a device with a circular bank of display lights installed in the housing at a location next to a fiber optic bundle so that the fiber optic bundle will receive light from the circular light bank. Both Fima and Garr have lights at the aft end. Combining Garr with Fima would produce a Fima lure with a ring of lights arranged about an intermediate section of the lure body.

In addition applicant again submits that a combination of the Fima and Garr references as suggested by the examiner is improper. There is no teaching, suggestion or

incentive to combine the references in a manner as suggested by the examiner. Fima already has a light at the aft end facing the optic fiber bundle. Garr also has a light at the end. There is no teaching to place the ring of lights around the mid-section of the Garr lure in any position but around a mid-section. There is no teaching or apparent reason to replace the light at the aft end of either Garr or Fima with a circular bank of lights.

Claim 15 is not obvious in view of the references in combination as suggested by the examiner. The proposed combination of references is improper. Accordingly allowance of claim 15 is respectfully requested.

Claims 16 through 23 depend from claim 1 or claims dependent thereon. Allowance of dependent claims 16 through 23 is respectfully requested.

In addition dependent claims 16 through 23 are patentable over the art for reasons set forth with respect to corresponding dependent claims above and it is thought unnecessary to repeat those arguments here.

Claims 24 and 25 have been rejected on Fima in view of Treon and Garr. Claim 24 recites a lure body housing with generally light-transmissive sidewalls and a jacket installed on the body made of a light-transmissive material. Claim 25 recites a lure body housing with generally light-transmissive sidewalls. It is the position of the examiner that Fima discloses a body made of light transmissive material. However the disclosure of Fima makes no reference to a body made of a light transmissive material and does not appear to have one. Fima has a body with an interior space that holds a light 38. Fiber optic bundles 44 extend through openings provided in the lure body to eyes 46 mounted on the lure body. Light is transmitted through the fiber optic bundles. Light is not transmitted through the body. Openings in the body to accommodate fiber optics do not

render the material of the body light-transmissive. The body is not made of a light transmissive material.

Claims 24 and 25 recite a first linear bank of display lights installed in the housing with light-transmissive walls, the bank of display lights including a set of spaced apart lights viewable through the sidewalls of the housing. However in the patent to Fima the light 38 is a single light. It is not a bank of lights much less a bank of spaced apart lights. The light 38 is not viewable through the sidewalls of the lure body. The optic fibers are not lights. The optic fibers carry lights. The optic fibers are installed in openings in the housing.

It is the position of the examiner that while Fima does not disclose a linear bank of display lights, Treon does. The examiner states that "Treon does disclose the first light – see the sidewalls of the lure in figure 1, is a linear bank of lights – see for example figure 1." However Treon discloses only a single light 32. It does not disclose a set of spaced apart lights. Light is transmitted from light 32 through strands of fiber optic bundles to various parts of the lure. The linear array of a series of ends of fiber optic strands is not a bank of spaced apart lights. The fiber optic strands and lights are entirely different elements as described in the specification of the application and recited in the claims. As disclosed in the patents to Fima and Treon the lights and fiber optic strands are entirely different elements.

Claims 24 and 25 recite a circular bank of display lights installed in the housing aft of the first linear bank of lights and including a set spaced apart, aft facing lights. Fima does not have such a circular bank of lights. There is a single light 40. There are no lights that are spaced apart. There is no circular bank of lights.

The examiner takes the position that Garr discloses a circular bank of display lights, and that it would have been obvious to one of ordinary skill in the art to take the device of Fima and add the circular bank of display lights of Garr. Garr discloses a fishing lure with external LED lights 3 located about the mid-section of the lure body, and a light 3 at the aft end of the lure body. A combination of Fima and Garr would not produce a device with a circular bank of display lights installed *in* the housing at a location next to a fiber optic bundle so that the fiber optic bundle will receive light from the circular light bank. Both Fima and Garr have lights at the aft end. Combining Garr with Fima would produce a Fima lure with a ring of lights arranged exteriorly about an intermediate section of the lure body. According allowance of claims 24 and 25 is respectfully requested.

Claims 26 through 28 depend from claim 25. For reasons earlier advanced, these claims are patentable. Allowance of these dependent claims is respectfully requested.

Respectfully Submitted,

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June 28, 2005

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